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IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Beeman, et al.

Confirmation No.: 1286

Application No.: 09/938,256

Examiner: Edwards, Patrick

Filing Date: 8-23-01

Group Art Unit: 2621

Title: System and Method for Facilitating Image Retrieval

Mail Stop Appeal Brief-Patents
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL OF REPLY BRIEF

Sir:

Transmitted herewith in *triplicate* is the Reply Brief with respect to the Examiner's Answer mailed on 9-8-05. This Reply Brief is being filed pursuant to 37 CFR 1.193(b) within two months of the date of the Examiner's Answer.

(Note: Extensions of time are not allowed under 37 CFR 1.136(a))

(Note: Failure to file a Reply Brief will result in dismissal of the Appeal as to the claims made subject to an expressly stated new grounds of rejection.)

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Respectfully submitted,

Beeman, et al.

By David R. Risley, Esq.

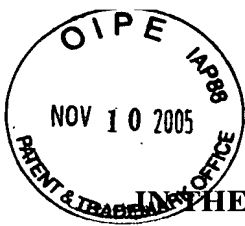
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:

Beeman, et al.

Group Art Unit: 2621

Serial No.: 09/938,256

Examiner: Edwards, Patrick

Filed: August 23, 2001

Docket No. 10003835-1

For: **System and Method for Facilitating Image Retrieval**

REPLY BRIEF RESPONSIVE TO EXAMINER'S ANSWER

Mail Stop: Appeal Brief-Patents
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P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

The Examiner's Answer mailed September 8, 2005 has been carefully considered. In response thereto, please consider the following remarks.

AUTHORIZATION TO DEBIT ACCOUNT

It is not believed that extensions of time or fees for net addition of claims are required, beyond those which may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor (including fees for net addition of claims) are hereby authorized to be charged to deposit account no. 08-2025.

REMARKS

The Examiner has provided in the Examiner's Answer various responses to arguments contained in Applicant's Appeal Brief. Applicant addresses those responses in the following. Applicant notes for the record that not every argument presented in Applicant's Appeal Brief was addressed in the Examiner's Answer, and Applicant incorporates each of those arguments by reference into the present Reply Brief.

I. Improper Treatment of an Explicit Claim Limitation Under MPEP § 2143.03 and Improper Final Status of Rejection

As an initial matter, Applicant reiterates that the rejection under 35 U.S.C. § 103 in view of Zhu and Kagami is **clearly improper** given that the Examiner has improperly "simply ignored" explicit limitations of Applicant's claims 9, 10, 21, 22, and 24-27 because, in the Examiner's opinion, those claims were indefinite under 35 U.S.C. § 112, second paragraph. See section A(1) of Applicant's "Arguments" in the Appeal Brief. The impropriety of the Examiner's dismissal of Applicant's explicit limitations is even more apparent now that the Examiner has **withdrawn** the rejections under 35 U.S.C. § 112. Therefore, the Examiner has "simply ignored" explicit recitations even though the underlying basis for ignoring them is acknowledged to be false. Applicant further notes that addressing those ignored recitations for the first time in the Examiner's Answer, after the Applicant identified the impropriety of the Examiner's treatment of Applicant's claims several times during prosecution, is also clearly improper. This equates to a denial of a full and fair opportunity to respond to the rejections made against Applicant's claims. Applicant

requests that this clear abuse of discretion be recognized and remedied by the Board of Patent Appeals and Interferences.

II. Examiner's Response to Arguments

The Examiner provides responses to some of Applicant's arguments in the "Response to Arguments" section of the Examiner's Answer. Applicant addresses those responses below.

First, the Examiner argues that Zhu teaches that a "default query is performed to generate a response set." Irrespective of whether this is true or not, this does not satisfy Applicant's explicit claim language. For example, claim 1 requires "querying a user as to at least one attribute of an image the user wishes to retrieve by posing a series of explicit questions to the user". The simple fact is that Zhu does not teach or suggest "querying a user" at all. Again, the Zhu system *receives* a search query *input by the user*. Specifically, the user selects a "query image," which is received by the Zhu system and is used to locate similar images for the user. Zhu, column 6, lines 8-18. Therefore, contrary to that alleged by the Examiner, *it is the user that queries the system, not the system that queries the user*. Accordingly, the Zhu system does not "query" the user at all, whether it be with explicit or "implicit" questions.

Furthermore, Zhu does not teach that his system poses any "implicit questions" to the user. The "implicit question" concept is one that was fabricated by the Examiner in a clear attempt to force an interpretation of the Zhu teachings that will approach Applicant's claim limitations. Contrary to that alleged by the Examiner, for the first time in the Examiner's Answer, Zhu's system does not "present a set of several images" to the user for selection of a query image, thereby "implicitly querying" the user as to an attribute of an image the user wishes to retrieve. Instead, Zhu merely

states that the user selects an image. See Zhu, column 6, lines 4-29. Accordingly, the user is *not* “prompted,” as is suggested by the Examiner, to select an image. This fact removes the basic premise on which the Examiner’s arguments in the Examiner’s Answer are based.

Second, the Examiner argues that the combination of Zhu and Kagami is proper. In particular, the Examiner argues that Zhu discloses “presenting questions” to a user and, therefore, it would have been obvious to combine Kagami’s teaching of posing questions to a user with Zhu’s system. Again, the basic underlying premise of this argument is erroneous given that Zhu does not pose any “questions” to the user, explicit, implicit, or otherwise. Therefore, the Examiner’s argument lacks merit.

As a further matter, Applicant reiterates that, rather being motivated to modify Zhu’s system to pose explicit questions as taught by Kagami, a person having ordinary skill in the art would be motivated *against* such a modification given that the modification would ***contradict the very nature of the Zhu system***. Again, the invention that Zhu describes is a system for retrieving related images based on “subject image content similarity-based retrieval”. We know this because that is the ***title*** of Zhu’s patent and the clear focus of the disclosure that follows. As such, the core concept of Zhu’s system is that images are retrieved based upon the similarity to the content of an image selected by the user (i.e., the query image) and provided to the system. To simply replace this functionality with a system that poses explicit questions to the user would completely obviate the need for Zhu’s system. In view of this, the proposed combination and modification is not proper under 35 U.S.C. § 103.

Given the above, Zhu actually **teaches away** from the modification suggested by the Examiner. As is well established in the law, “[t]here is no suggestion to combine . . . if a reference teaches away from its combination with another source . . . A

reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant . . .” *Tec Air, Inc. v. Denso Manufacturing Michigan Inc.*, 192 F.3d 1353, 52 USPQ2d 1294 (Fed. Cir. 1999). Even if one did not agree that Zhu teaches away from the modification suggested by the Examiner, it is at least clear that the lack of motivation or suggestion in the prior art to make the suggested modification is evidence that the motivation or suggestion is actually being taken from Applicant’s own disclosure. As is well established in the law, such hindsight to the Applicant’s own disclosure is *per se* improper. *See Crown Operations International, Ltd. v. Solutia, Inc.*, 289 F.3d 1367, 62 USPQ2d 1917 (Fed. Cir. 2002) (*a determination of obviousness cannot be based on a hindsight combination of components selectively culled from the prior art to fit the parameters of the invention*).

Third, the Examiner now, for the first time, addresses the limitation “during an image storage process” as it appears in claims 9, 10, 21, 22, and 24-27. Applicant again objects to the manner in which that limitation was ignored during prosecution, despite Applicant’s objections raised during prosecution. As for the merits of the arguments now provided in the Examiner’s Answer, the Examiner argues that Zhu teaches prompting the user for keywords or phrases “during an image storage process” and generally cites “Figs. 2 and 7” of the Zhu reference for support. Those figures, however, only describe a “retrieval” process not a “storage process”. Therefore, the argument is flawed. Specifically, the actions described in Figures 2 and 7 of the Zhu reference are performed when a user is searching for an image, *not* when the system is storing an image. The only “storing” described in those figures is storing a “candidate set” of images that are retrieved after the user provides a query image during an image

search. See, e.g., blocks S310, S320, S330, S332, and S335 of Figure 7. Therefore, no “image” is being stored. Only an identified grouping of images (i.e., an association of already-stored images) is stored.

As a final matter, Applicant notes that the Examiner has not addressed Applicant’s arguments as to the limitations present in Applicant’s dependent claims, which were discussed in the “Arguments” section of the Appeal Brief. Applicant asserts that this omission is tantamount to an admission that neither Zhu nor Kagami teach or suggest those limitations.

III. New Rejection Under 35 U.S.C. § 102

The Examiner now, for the first time, rejects claims “1-27” under 35 U.S.C. § 102(b) as being clearly anticipated by Kagami. Applicant notes that claim 2 has been canceled. Applicant further notes that this new rejection just underscores the weakness of the rejection under Zhu/Kagami.

As an initial matter, Applicant notes that Kagami teaches no “method for facilitating image retrieval”. Instead, Kagami discloses a data processing method and apparatus for supporting “analysis judgment.” Kagami, Patent Title. Specifically, the Kagami apparatus presents various questions to the user about an object to obtain the user’s appraisal of the object by “kansei,” which Kagami describes as an analysis/judgment based upon human sensitivity. Kagami, column 3, lines 1-11; column 1, lines 11-17. Through this process, the user evaluates an object in terms of the user’s “fashion sense and preference which is human’s ambiguous reactive characteristic for a sense.” Kagami, column 1, lines 13-14. Therefore, Kagami fails to even teach or suggest the basic method that is being described in independent claims 1 and 11.

The Examiner argues that Kagami teaches “querying a user as to at least one attribute of an image the user wishes to retrieve by posing a series of explicit questions to the user”, “receiving explicit user responses to the posed questions”, and “presenting at least one image to the user based upon the user responses”. Even assuming that Kagami teaches querying a user as to an object that is shown to the user for evaluation, Kagami does not teach querying a user as to at least one “attribute of an image”. In particular, Kagami queries the user as to his or her evaluation of an object, not an “attribute of an image”. In other words, Kagami is concerned about impressions about an object contained in an image, not about the image itself. Moreover, Kagami clearly does not teach querying a user as to at least one attribute of “an image that the user wishes to retrieve”. This is understandable given that, as is noted above, Kagami’s system is not an image retrieval system. Instead, Kagami’s system is used to obtain fashion evaluations of objects.

In view of the above, it is clear that Kagami fails to teach “querying a user as to at least one attribute of an image the user wishes to retrieve by posing a series of explicit questions to the user” as in claim 1, “means for querying a user as to attributes of an image the user wishes to retrieve by posing a series of explicit questions to the user” as in claim 11, or “logic configured to generate and present explicit questions for a user that are designed to elicit responses as to attributes of an image the user wishes to retrieve” as in claim 16. For at least these reasons, Kagami does not anticipate claims 1, 11, or 16, or the claims that depend from those claims.

Regarding Applicant’s dependent claims, Kagami fails to teach eliminating “potential image matches” in response to the received responses. Specifically, Kagami is not concerned with finding potential images for the user.

Regarding claim 5, Kagami fails to teach prompting the user to explicitly identify an “image attribute of an image presented to the user so as to increase the proficiency with which images are retrieved for the user”. Kagami is not concerned with retrieving images for the user.

Regarding claim 6, Kagami fails to teach “storing image metadata in response to the user identification, the metadata identifying the image as containing the image attribute that the user identified”. Contrary to that alleged by the Examiner, Kagami’s column 9, lines 37-46 and column 10, lines 1-9 say nothing about storing “image metadata”.

Regarding claim 7, Kagami fails to teach “prompting the user to identify select images of the images presented to the user that each contains a particular image attribute so as to increase the proficiency with which images are retrieved for the user”. Again, Kagami’s system is not for retrieving images.

Regarding claim 8, Kagami fails to teach “storing image metadata in response to the user identification, the metadata identifying the select images as each containing the particular image attribute”. See the discussion of claim 6.

Regarding claim 9, Kagami does not teach analyzing images for a recognizable image attribute “during an image storing process”. Kagami’s column 5, lines 42-50 provide no such teaching.

Regarding claim 10, Kagami does not teach “storing image metadata in response to the analyzing, the metadata identifying an analyzed image as containing the recognizable image attribute”. See the discussion of claim 6.

Regarding claim 13, Kagami does not teach “means for storing an image metadata in response to user identification of image attributes, the metadata

identifying image as containing the image attributes that the user identified”. See the discussion of claim 6.

Regarding claim 14, Kagami fails to teach “means for analyzing images for a recognizable image attribute during an image storing process”. See the discussion of claim 9.

Regarding claim 15, Kagami does not teach “means for storing image metadata in response to the analyzing of the images, the metadata identifying an analyzed image as containing the recognizable image attribute”. See the discussion of claim 10.

Regarding claim 18, Kagami fails to teach “logic configured to store image metadata in response to the user identification, the metadata identifying the image as containing the image attribute that the user identified”. See the discussion of claim 6.

Regarding claim 19, Kagami fails to teach “logic configured to analyze images for a recognizable image attribute during an image storing process”. See the discussion of claim 9.

Regarding claim 20, Kagami does not teach “logic configured to store image metadata in response to the analyzing of the images, the metadata identifying an analyzed image as containing the recognizable image attribute”. See the discussion of claim 10.

Regarding claims 21, 24, and 26, Kagami fails to teach “prompting the user for keywords or phrases during an image storing process, the keywords or phrases being relevant to content of an image” or means or logic for such prompting. Kagami only prompts the user for impressions. No “keywords phrases” are obtained, and no such information is obtained during an image storing process for reasons described above.

Regarding claims 22, 25, and 27, Kagami does not teach “storing keywords as metadata in response to receiving keywords or phrases provided by the user, the metadata identifying the image as containing content described by the keywords or phrases” or means or logic for such storing. See the discussion of claim 6.

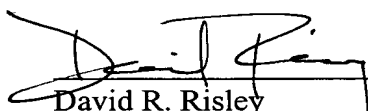
Regarding claim 23, Kagami does not teach “explicitly selecting a portion of an image presented to the user”. Simply stated, Kagami does not prompt the user to select any “portion of an image”. Instead, Kagami only prompts the user for impressions as to an object contained in an image.

I

CONCLUSION

In summary, it is Applicant's position that Applicant's claims are patentable over the applied prior art references and that the rejection of these claims should be withdrawn. Appellant therefore respectfully requests that the Board of Appeals overturn the Examiner's rejection and allow Applicant's pending claims.

Respectfully submitted,



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Registration No. 39,345

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11-8-05

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